

# Spring Meeting 2002: Business Law and Intellectual Property Law Sections Joint Session

## Cyber Space Odyssey 2002:

# Famous People, Trademarks and Domain Names

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# Domain Name as a Trademark...

## P.T.O. and TM.Com

- **As an address**, a Domain Name does not serve to indicate source.
  - Attorney who used his “www...” on letterhead among his addresses does not make of it an acceptable “use.” as a source identifier for legal services, it is *In re Eilberg*, 49 USPQ2d 1955 (TTAB 1998).
- **Advertises Applicant’s own services** is not itself a “service.”
  - Use of a DOTCOM...”for the sole purpose of advertising their own products or services cannot register a domain name used to identify that activity.” *In re Reichhold Chemicals, Inc.*, 167 USPQ 376 (TTAB 1970); TMEP §1301.01(a)(ii)
- **SURNAMES**
  - If a mark is composed of a surname and a TLD, the mark is primarily merely a surname under 15 U.S.C. §1052(e)(4).
  - A TLD has no trademark significance.
  - If the primary significance of a term is that of a surname, adding a TLD to the surname does not alter the primary significance of the mark as a surname.
- **Full Story, Get: P.T.O. Examination Guide No. 2-99 September 29, 1999 online at [www.uspto.gov](http://www.uspto.gov)**

# Courts may use foreign law against U.S. user, and U.S. law against a Foreign Judgment...

- **Barcelona.Com, Inc. v. Excelentísimo Ayuntamiento de Barcelona**  
2002 WL 359759 E.D.Va. (Feb. 22, 2002)

  - Cannot use name of European cities even with a legitimate travel business aimed at boosting tourism there.
  - US Court used Spain Law for Trademark validity
    - First to properly register a trademark is the only legally authorized user.
  - is not bound by an ICANN decision and
  - *Followed Spain law* to determine bad faith & Trademark validity.
    - The Defendant had no right to use the first-registered mark under Spanish law and thus the use and attempts to sell were bad faith.
- **Yahoo and the unwanted memorabilia, Yahoo! V. La Ligue Contre Le Racisme Et L'Antisemitisme, C-00-21275 JF19**

  - 1<sup>st</sup> amendment will protect US version of services aimed at the world from the effect of a French court ruling if to enforce the order would be abhorrent to the Constitution.

# Exporting the First Amendment? Sucks sites

- **SUCKS websites may be legitimate comment**, criticism - Exporting the 1<sup>st</sup> Amendment?:
  - Prepare to defend your GOOD NAME
- Defamatory statements are protected
  - Savin Copiers unable to “get” SavinSUCKS.COM:
    - The Panel did not believe the public would be confused by finding savinsucks.com skince it was obviously a commentary site and
    - Complainant has not alleged that Respondent’s domain name is “identical” to Complainant’s trademark.
    - The examples of bad faith in the Policy have at least one element in common: ... that the respondent, at the time the domain name was registered, harbored an ***intent that related in some manner to the complainant or its trademark.***
      - Savin Corporation v. savinsucks.com (Claim Number: FA0201000103982 **March 5, 2002**)
    - The Panel: “Although Complainant’s **trademark rights** are valid, they are nonetheless **limited by the Respondent’s First Amendment rights**. Under the First Amendment of the United States Constitution, **Respondent has an unfettered right to hold or express his opinion ...that ‘Savin Sucks’...**”

# Exporting the First Amendment? UDRP

- NO 1<sup>st</sup> Amendment in UDRP – WIPO panel limits use: in transferring [wal-martcanadasucks.com](http://wal-martcanadasucks.com) to the complainant, “The Panel ... decision does not address *legitimate freedom of expression sites* ... [do not] characterize this decision as seeking to stifle freedom of expression ... by ordering the transfer of "sucks" formative names. ...this decision to serve[s] neither ...aim. This decision is directed to a blatant abuse of the domain name registration process -- no more, no less.”
  - The panel found the use was commercial, and “not within the scope of fair use or legitimate noncommercial use permitted by paragraph 4(c)(iii) of the Policy”
    - Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico, (July 20, 2000) WIPO Case No. D2000-0477

# Jurisdiction: Major Issues to Tackle 1<sup>st</sup>

- ❑ Tricky Internet jurisdiction A Major Factor in all Unfair Competition Cases:
  - Zippo Test: sliding scale of interactivity with customers  
[Zippo Manuf. Co. v. Zippo Dot Com. Inc. (W.D. Pa. 1996)] 952 F. Supp. 1119, 1124]
  - Panavision Test: effects purposely directed at forum  
[Panavision Int'l, v. Toeppen, 938 F. Supp. 616 (C.D. Cal. 1996)]
  - Cybersell Contacts: no contacts with Arizona other than maintaining a home page that is accessible to Arizonans [130 F.3d 414 (9th Cir. 1997)]
  - Yahoo – International jurisdiction over contents of site
    - ❑ **Not enforceable if it is against 1<sup>st</sup> Amendment**
  - Ford cases – Later – Sue in forum of Registrar for In Rem & do not have in personam jurisdiction.

# Domain Names 2002: Working a Balance

- ❑ **Internet Changed the Trademark Rules**
  - Instant “use” and worldwide publication of Trademarks
  - NSI had instant litigation and invented 1<sup>st</sup> Domain Name Resolution system.
  - UDRP under ICANN followed – better but criticised.
- ❑ **Two Main Action Forums:**
  - **ICANN ADR is the Worldwide UDRP Organized by NSF**
  - **ACPA in U.S. Courts 15 U.S.C. 1125(d)**
    - ❑ In conjunction with Declaratory Relief in appeals from UDRP
    - ❑ UDRP- Stayed while a Court Action proceeds?
- ❑ **Domain Names** are not easy to obtain & keep:  
(Corinthians.com)
  - Lost to U.S. poster on WWW of biblical passages
    - ❑ Corinthians Licenciamentos LTDA v. David Sallen, Sallen Enterprises, and J. D. Sallen Enterprises Case No. D2000-0461
  - Gained back in ACPA- Dec. Action.
- ❑ **Playing field may increase\***
  - \* Predict that the “.COM” will remain most popular and sales of other and new TLDs will be slack.

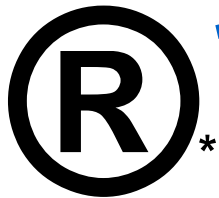
# If you are Famous: UDRP vs. ACPA or both...

- ❑ First Amendment & Right of Publicity Play Roles in U.S. - Based and UDRP cases involving US litigants.
- ❑ UDRP Does Not have to use any particular law
  - It is suggested a BEST PRACTICE: define what law an arbitrator applies in contract.
  - Rollerblade® + ing = verb is “generic” as used by the Respondent thus weak Trademark rights.
    - ❑ *Rollerblade, Inc. v. CBNO*. [rollerblading.com] Case No. D2000-00427 August 24, 2000
  - Unusually large amount of other case citations – be in control, explain the law you will use and how it applies or arbitrator may supply what they know best.
    - ❑ Use of law of both countries where litigants from US and switzerland Isabelle Adjande
- ❑ UDRP: Shop for Arbitrator Panels Carefully
  - Arbitrators can be arbitrary
  - Use contract terms to specify Law and Details of ADR
  - Review Past decisions by arbitrators
  - SEE: [www.incann.org](http://www.incann.org)



# Trademark Overview – What is registered carries more weight

## ▣ Trademarks & Domain Names



- USE a mark in IN COMMERCE or INTERNATIONALLY (U.S. only!)
- Register TMs all other places. (use examining registers not Tunisia- Madonna Case)
- Use of WWW & Domain Names to do immediate national and international advertising.
- Forum: UDRP and/or ACPA

***\*Do Not use “®” until registered!***

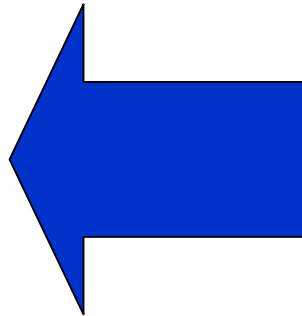
# U.S. – EU and Personal Names

- **U.S. Trademarks: Right by USE under Lanham Act**
  - Trademarks represent most of the Good Will of the Institution to the Consumer.
  - Internet Domain Names behave like Trademarks
    - Courts do not always treat them like Trademarks
    - Ford vs greatnames lack of jurisdiction over register of Domain Name prevents suit on ACPA grounds (15 U.S.C. 1125(d))
  - Can be used to BRAND a new Service or Product
- **EU- FIRST TO REGISTER**
  - **U.S. ALLOWS ITU** applications for near - filing date use
- **P.T.O. Policy on Person's Names:**
  - **Abba Case:** Must use on *series of goods* and
  - Be used as the *source* identifier and not just the name of the person.
    - "ABBA" used on albums – was not the *source* the record company?
  - Affects whether a name can be *registered*.
  - **IN RE POLAR MUSIC INTERN. AB**, 714 F.2d 1567, 221 U.S.P.Q. 315 (C.A.Fed.,1983.)
    - Merely identifies the Band: ... "applicant has done no more than show the name of the recording group, "TOYZ", on a record cover. Such a showing " \* \* \* will not by itself enable that name to be registered as a trademark."
      - *In re Peter Spirer* 225 U.S.P.Q. 693 P.T.O. (T.T.A.B. Feb. 27, 1985)

# Fanciful to Descriptive

## □ Fanciful: Strongest marks

- Not Descriptive Marks to be Registered should be Fanciful on a spectrum from “**Xerox**”- “**KODAK**” –
- Can be registered on U.S. Principal Register

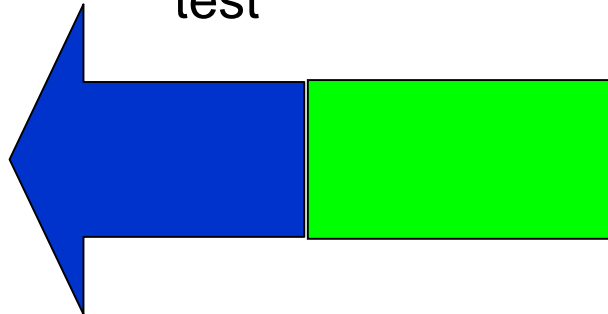


# Fanciful to Descriptive

## □ Suggestive: Weak but Registrable

- Not Descriptive but close to it:  
**“MOVIEBUFF” for a database of movie information\***

- Needs test - Imagination test –Competitors Use test



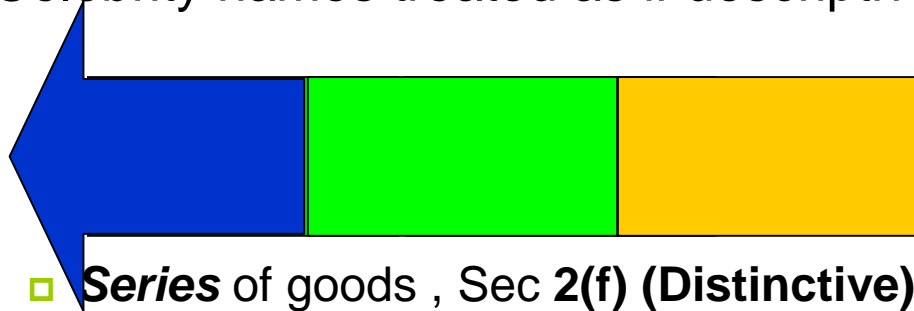
Brookfield Communications, Inc. v. West Coast Entertainment Corp., (9th cir. 1999)

174 F.3d 1036, 1058, 50 U.S.P.Q.2d 1545, 1561

# Fanciful to Descriptive

## □ Descriptive: Not usually Registrable

- Tells what it actually is "**FirsTier**" was merely descriptive of banking services\*
- Usually cannot be registered on U.S. Principal Register – maybe after time & Secondary Meaning
- Celebrity names treated as if descriptive of person

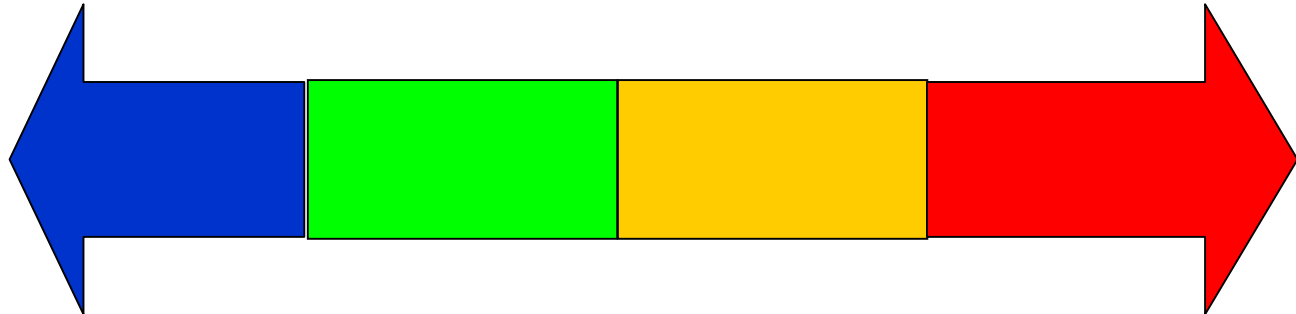


- **Series** of goods , Sec 2(f) (Distinctive) Secondary Meaning exceptions.

\*(In re Omaha Nat'l Corp., (Fed. Cir. 1987)  
819 F.2d 1117, 2 U.S.P.Q.2d 1859).

# Fanciful to Descriptive

- Generic & Geographically –  
Descriptive / Misdescriptive:  
Weakest “South Bank” (discussed later)
  - Usually cannot be registered in U.S.–maybe  
after a LONG time & Secondary Meaning



# Trademark Prosecutions can curb Domain Name rights...

- A registered Trademark is more likely to prevail over an unregistered mark
  - But a mere unexamined “otc” registration from Tunisia may not be recognized to defeat Madonna.
    - *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"* Case No. D2000-0847 Case No. WIPO D2000-0847 **October 12, 2000**
- If P.T.O. denies registration there is a Prosecution History in the *File Wrapper* evidence either side may use.
  - If a mark was not registered because it was
    - Generic
    - Descriptive or
    - Geographical
  - It may lose a UDRP action.
- Standards for “Confusingly Similar” differ from USA to UDRP
  - UDRP uses no standard US uses Case law tests: *Sleekcraft* Factors
    - *AMF v. Sleekcraft* 204 U.S.P.Q. 808 (9<sup>th</sup> Cir, 1979)

# Relationship Between Trademarks and Domain Names

- Domain Name is international.
  - Trademark only viable in country where it is registered. No extraterritorial effect.
  - **NEW**: Madrid Protocols allow for international registrations. Congress is working on it.
- Domain Name Capable of identifying source of a web site.
  - Trademark identifies source of goods/services.
- Domain Names are all unique BUT FOR the TLD (the dotcom-dotnet-dotinfo).
  - Trademarks can be identical but if on different goods, they can both be registered.
  - P.T.O. - Domain Names as Reg'd Trademarks – analogous to an 800-number.



# Interplay between UDRP and ACPA

## Sanctions for Too Many Cases:

- *Storey v. Cello Holdings, L.L.C.* (S.D.N.Y., 2002) 182 F.Supp.2d 355 attorney held for sanctions, attorney fees and coverage of Court costs. Cello Company Limited sued Storey for the Domain Name it wanted. The Cello attys advised the Court it had settled, though it was only discontinued by Cello.
- Later Cello complained under UDRP to eResoulution.
- Then, *while the ADR was pending*, Cello filed complaint in New York for the Domain Name asking for a Declaratory Judgment that Storey was not in bad faith. The eResolutioun Panel held for Cello and the New York action was dismissed for lack of merit regarding the word Cello as a Trademark.
- Attorneys misrepresented the nature of the “dismissal” & they had a pending case in Court while filing the UDRP claims.
- Because the proceedings were almost identical in the UDRP and original actions, “--for precisely the same reasons--the alleged confusion between Cello's mark "Cello" and "cello.com.”
  - Cello was barred from reasserting its claims in the arbitration proceedings.
  - The bottom line of this is do not attempt to use UDRP as a substitute for a Court action.

# Interplay between UDRP and ACPA

## Declaratory Relief and ACPA as Appeal from UDRP

- ❑ ICANN waits - 10 days to file
- ❑ Dec. Action to Repair UDRP errors:
  - 15 U.S.C. § 1114(2)(D)(v) – ACPA - Reactivation
    - ❑ A civil action to establish registration of a domain name is not unlawful injunctive relief to the domain name registrant, including reactivation of the domain name or transfer of the domain name to the domain name registrant.
  - 28 U.S.C. § 2201 - Declaratory Relief Actions
    - ❑ For Declaration use of Domain Name is not unlawful
  - SALLEN v. CORINTHIANS LICENCIAMENTOS LTDA No. 01-1197 U.S.C.A. 1<sup>st</sup> DIST MASS. (Dec. 5, 2001)
    - ❑ Overturned a UDRP-ICANN ADR Ruling to RETURN a Domain Name to a registrant – former Respondent in the UDRP action.

# UDRP, WIPO and UN Policy

- UN policy: *Registered Trademark* has most validity in disputes.
- WIPO Policy- *Famous Names do not have Trademark rights if they do not have commercial value.*  
(*Kennedy Townsend v. Birt* WIPO D2002-0030 4/11/02)
  - WIPO: "...protection of an individual politician's name no matter how famous, is outside the scope of the Policy since it is not connected with commercial exploitation as set forth in the...Report."
  - WIPO 2<sup>nd</sup> Report: Policy on famous names that if the name did not itself raise funds or have commercial activity, it cannot be given Trademark rights.
  - NO alter-ego in political Complainant and her fund raising corporations. Only the "Friends of" should file since it is the fund raising entity.
  - Next time try the NAF or ACPA.

# UDRP Rules: Paragraph 4(a)

## Basic Elements

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- ❑ Paragraph 4(a) of the Policy directs that the complainant must **prove each** of the following:
- ❑ (i) that the domain name registered by the respondent is **identical or confusingly similar to a trademark or service mark** in which the complainant has rights; and,
- ❑ (ii) that the **respondent has no legitimate interests** in respect of the domain name; and,
- ❑ (iii) that the domain name has been registered and used in **bad faith**.

# UDRP Rules: Paragraph 4(a)(iii) – Bad Faith Use

- “...Without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:
- (i) circumstances indicating that you have registered or you have acquired the domain name **primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant** who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
  - (ii) you have registered the domain name in order **to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name**, provided that you have engaged in a pattern of such conduct; or
  - (iii) you have registered the domain name primarily for the purpose of **disrupting the business of a competitor**; or
  - (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by **creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location** or of a product or service on your web site or location.”

# UDRP: Springsteen Case

Arbitration can be arbitrary:

- *Bruce Springsteen -v- Jeff Burgar and Bruce Springsteen Club* Case No. D2000-1532.
  - The panel “under 4(b)(ii) of the UDRP held that the registration of the Domain Name had to prevent the owner of a trade mark or service mark from reflecting the mark “in a corresponding domain name”... Bruce had been able to register a “.NET” version, he lost.
  - Criticism: It may not be good faith to use the ONLY “.COM” available because Users might believe the “COM” to be the true official site for an artist. See: *Celine Dion and Sony Music Entertainment (Canada) Inc. v. Jeff Burgar operating or carrying on business as Celine Dion Club*, Case No. D2000-1838
    - **BEST PRACTICE: Gather and be ready to present ALL evidence you have on trademark rights and use!**

# UDRP: C'mon, Now... Famous and Political

**Madonna** – lots of proof, different panel and continuing, well used, ®registered trademarks makes a difference.

- Respondent here asserted use of a “dictionary word”, and the panel agreed there is another use of the name.
  - We find instead that name was selected and used by Respondent with the intent to attract for commercial gain Internet users to Respondent’s web site by trading on the fame of Complainant’s mark. His Tunisia registration of no moment
  - *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"* Case No. D2000-0847 Case No. WIPO D2000-0847 **October 12, 2000**

□ **Garth Brooks with ®eg’d Trademarks**

- simply operating a “fan-site” is a no-no without proper linking, Name & likeness, Trademark and other licenses:
  - While the Respondent has not yet attempted to sell the site, it is or has been in the line of business of selling Domain Names.
  - “... given the nature of Respondent’s other businesses in the business of the brokerage and registration and sale of domain names, it is *reasonable to infer that Respondent registered the domain name with the intent to attract Internet users for commercial gain.*”
  - *Garth Brooks v Commbine.com, LLC* WIPO Claim Number: FA0011000096097. **January 3, 2001**

□ **KennedyTownsend** WIPO: “...protection of an **individual politician’s name** no matter how famous, is outside the scope of the Policy since it is not connected with commercial exploitation as set forth in the...Report.”

- WIPO 2<sup>nd</sup> Report: Policy on famous names that if the name did not itself raise funds or have commercial activity, it cannot be given Trademark rights.
  - NO alter-ego in political Complainant and her fund raising corporations. Only the “Friends of” should file since it is the fund raising entity.
  - *KennedyTownsend v. Bir* WIPO D2002-0030 **4/11/02**

# U.S.A.: Anticybersquatting Consumer Protection Act Elements:

- Ticket to:
  - Original Action
  - UDRP appeals and
  - Declaratory Relief Actions
- ELEMENTS:
  - One who “Registers, **traffics** in, or uses a domain name of a **mark that is distinctive** at the time of registration of the domain name that is **identical or confusingly similar** to that mark **or mark that is famous** at the time of registration of the domain name, is identical or confusingly similar to **or dilutive** of that mark.
  - **With the bad faith intent** to profit from that mark...
  - Domain Name registrant could:
    - Lose the Domain Name
    - Pay Money Damages
    - Have Domain Name put on hold
    - 15 U.S.C. 1125 (d)(1)(A)



# ACPA Bad Faith Intent to Profit - Factors:

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- Applies Traditional US trademark notions of first to use and nature and extent of use.
- Jurisdiction over the “Res” and In Rem
  - Personal Jurisdiction can be difficult to obtain.
- Virginia and California are target states
  - California because ICANN is here.
- Best Practice: Register important Trademarks
  - Note that over 250,000 marks were applied for in 2000 in the US – PTO.
  - Register INTERNATIONALLY
  - Domain Name registrations declined 2001.
  - DOT-COM Trademark registrations seriously declined in 2001.

# ACPA Bad Faith Intent- Offers to sell the Domain Name:

- **Offers to sell:** to the trademark owner or others hold the Domain Name for ransom, Especially for more than the cost of registration.
- The **quantity of the Domain Name user's content** that might be "valid" content:
  - 1<sup>st</sup> Amendment "content" concerns – The "Sucks" cases
- Did the **Domain Name registrant know** the offended trademark?
  - SPORTY'S FARM L.L.C., v.SPORTSMAN'S MARKET, INC,  
Docket Nos. 98-7452(L), 98-7538(XAP) U.S.C.A., 2<sup>nd</sup> Cir.  
Feb. 02, 2000, 2000 WL 124389.
  - "Cybersquatting involves the registration as domain names of well-known trademarks by non-trademark holders who then try to sell the names back to the trademark owners."

# ACPA In Rem Action: When The Bad Guy is Not Available

- ❑ **15 U.S.C. 1125 (d) (2) (A) provides for an In Rem action –**
- ❑ In Rem - against the property rights in a Domain Name
- ❑ If you **cannot locate** the Domain Name Registrant ***by notice***
- ❑ Then you may, by **publication** of notice as ordered by a court, obtain in rem jurisdiction in the **district of the Court where the register has its offices.**
- ❑ **Best Practice:** Be sure to follow the exact statutory requirements of attempted notice and other steps to insure proper jurisdiction.

# ACPA Retroactivity, Money Damages

- ❑ ***Applies*** to domain names that were registered before and ***used after*** the ***law's*** enactment, ***however***.
- ❑ **Injunctive relief** and transfer of the domain name are the *only available remedies* if the *domain name* was *registered before* the law's enactment.
- ❑ Money Damages (whether actual or statutory) are available only if the domain name was registered after the law's enactment (which was Nov. 29, 1999).
  - Need to show actual loss by lack of “hits” to YOUR site before & after the offending Domain Name!
  - It is easier to show Squatter’s profits made in bad faith.
  - Joseph C. Shields dba Joe Cartoon Co.v. Zuccarini (April 24, 2001 U.S.C.A. 3<sup>rd</sup> CIR. No. 00-2236)
  - Damages based on “punitive” theory Statutory Damages **\$10,000/Domain Name, x8.**

## *Is a Domain Name "Property?"*

Recent case: Network Solutions Inc vs. Umbro International  
Va. S. Court 4/21/00 No 991168, suggests that if the URL is a or permits a *service*, it is *not garnishable* under Virginia's garnishment laws.

- ❑ 15 U.S.C. Sec. 1125 (d) allows courts to order the Domain Name register to turn over a URL to a trademark owner.
- ❑ No Money Damages in an In rem Action.
- ❑ NSI position: URL is service connecting computers by an alphanumeric system and NO MORE.
- ❑ May be transferred by contract.
- ❑ Domain Name may take on the Properties of a Trademark
  - Become a source indicator for goods sold, services rendered
  - Become famous and go with the good will (AMAZON.COM)
  - Can be registered as Trademark with the DOT COM

# Domain Name Registrants Rights

- Domain Name Registrants have rights to use a name that suits their legitimate needs and to express opinions. The law will continue to strike a balance between conflicting rights.
  - Right to register Domain Name for Sale (*South Bank*)
  - Right to Express opinion [“Sucks” sites] (*Bihari Case*)
  - Right to Comment on a Copyrighted Work (*ACPA CA Business & Professions Code* )
  - Right to hide behind lack of commercialism:
    - Ford: Cases in Point

# UDRP: Domain Name Registrants Rights

## *SOUTH Bank v. Media Street*

The one that got away...

- ❑ South bank had *not registered* a Trademark and mark is *weak as geographically descriptive*.
  - Registration adds: Presumption of Ownership & Validity in U.S.
- ❑ Geographical descriptions do NOT a strong mark make:
  - “South Bank” is a business center in London
  - Shows international nature of Domain Names
  - Web developer had, therefore “legitimate” uses for “south bank.com” as the South Bank\* of the Thames
    - ❑ \*a new business district
  - *SOUTH Bank v. Media Street*, Case No. D2001-0294 (WIPO, April, 2001)

# Domain Name Registrants Rights

## Cybersquatters Rights?



### Loses 2 to Dilution & an Infamous Cybersquatter

- **Dilution:** The site: [www.greatdomains.com](http://www.greatdomains.com) is an auction site specializing in auctioning Internet domain names
  - Owners of the site do not own the Domain Names.
  - Third parties sell such names as “fordparts.com” and “volvoparts.com”
  - Thus, Great Domains cannot be trafficking in that which it has no rights to. Therefore There can also be no cybersquatting.
    - Ford Motor Co. v. Greatdomains.Com, Inc. 177 F.Supp.2d 635E.D.Mich., 2001. Dec. 20, 2001.
- **ACPA:** The site [www.2600.com](http://www.2600.com) is a famous hackers site\*. Its owner, Mr. Corley has been sued and taken through UDRP many times for cybersquatting. Yet, Ford, with registered Trademark and an old venerable name was not able to stop him...
  - Recall *Universal v Corley et al.*? 111 F. Supp. 2d 348



## Lack of Commercialism as Shield under ACPA, Trademark and Dilution Statutes

- Ford sued: Fuckgeneralmotors.com: Dilution and Trademark claims
  - No commercial website – just links to GM called “cyberart”
  - creative use of links, no commercial use of the link and “***The essence of the Internet is that sites are connected to facilitate access to information.***”
  - Similar to Kennedy UDRP case.
  - injunction against another person's *commercial use* in commerce of a mark: 15 U.S.C. § 1125 (c ) Dilution

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


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# The Future

- More Complexity and NEW gTLDs
  - Intellectual property Audit to turn up potential marks
  - Care in Searching all potential Marks
  - Register in All Places Business Located + International
  - Make them Registrable
  - Obtain URLs early on
  - ICANN Going through throes of infancy
    - *UDRP Rules can be changed at any time.*
    - Criticisms: Too Trademark – owner oriented.
- Chose your weapons...
  - ACPA best for Famous Names and Appeal from UDRP.
  - UDRP keeps cost down – use with caution.

## Bottom Lines:

- ❑ Register Trademarks!
- ❑ Obtain All permutations of Domain Names
  - Register SUCKS versions.
- ❑ Use Phrase marks: “Pulling for you since 1852” (WFB), distinguishes your client’s services from the rest.
- ❑ Select marks carefully especially IF they are also to become Domain Names.
- ❑ *Keep Litigation costs down – plan way ahead* – searches are not enough – analysis must be international.



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**Thank You for your attention**

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